

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

AMGEN INC.,

Plaintiff,

v.

AMNEAL PHARMACEUTICALS LLC, et al.,

Defendants.

Civ. No. 16-853-MSG
CONSOLIDATED

ORDER

This is a consolidated patent infringement action whereby plaintiff Amgen, Inc. (“Amgen”) has asserted claims of infringement against Defendants Amneal Pharmaceuticals LLC and Amneal Pharmaceuticals of New York LLC (collectively, “Amneal”), Piramal Healthcare UK Ltd. (“Piramal”), Watson Laboratories, Inc., Actavis, Inc., and Actavis Pharma, Inc. (collectively, “Watson”), and Zydus Pharmaceuticals (USA) Inc. and Cadila Healthcare Ltd. (collectively, “Zydus”). Amgen asserts that Defendants infringed claims of United States Patent No. 9,375,405 (the “’405 patent”). (D.I. 293, Ex. 2 at ¶¶ 25-26, 35-36, 39-42). Defendants filed counterclaims asserting that the ’405 patent is invalid. (*See* D.I. 13, C.A. No. 16-925; D.I. 8, C.A. No. 17-713; D.I. 14, C.A. No. 16-855; D.I. 99, C.A. No. 16-853).

I bifurcated the infringement claims from the invalidity counterclaims, and held a four-day bench trial on infringement between March 5, 2018 and March 9, 2018. (D.I. 375 at 2). On July 27, 2018, I issued a trial opinion and order holding that Amneal, Piramal, and Watson did not infringe the ’405 patent. (D.I. 375; D.I. 376). The outcome for Zydus, however, was different. I held that Zydus did not infringe claims 18 and 20 of the ’405 patent, but did infringe claims 1-4, 6, 8-9, 15-17, and 19. (D.I. 376 at ¶¶ 4-5).

During trial, both Amneal and Zydus filed a Motion for Judgment Pursuant to Fed. R. Civ. P. 52(c). (D.I. 325; D.I. 337). After receiving the court's trial opinion, Zydus filed a Motion to Amend the Findings and Judgment of Infringement pursuant to Fed. R. Civ. P. 52(b), 59(e), and 60(b). (D.I. 379). Finally, I have not yet held trial on the invalidity counterclaims. On August 23, 2018, I held a status conference with the parties to discuss their proposals on scheduling and/or resolving these outstanding issues. (D.I. 382).

NOW THEREFORE, IT IS HEREBY ORDERED that:

1. The invalidity counterclaims of Amneal (D.I. 13, C.A. No. 16-925), Piramal (D.I. 8, C.A. No. 17-713), and Watson (D.I. 14, C.A. No. 16-855) are DISMISSED without prejudice as moot;¹

2. Amneal's Motion for Judgment Pursuant to Fed. R. Civ. P. 52(c) (D.I. 325) is DENIED as moot;

3. A judgment of NON-INFRINGEMENT of claims 1-4, 6, 8-12, and 14-18 of the '405 patent shall be entered in favor of Amneal and against Amgen;

4. A judgment of NON-INFRINGEMENT of claims 1-6 and 8-20 of the '405 patent shall be entered in favor of Piramal and against Amgen;

5. A judgment of NON-INFRINGEMENT of claims 1-6 and 8-20 of the '405 patent shall be entered in favor of Watson and against Amgen;

¹ "A district court judge faced with an invalidity counterclaim challenging a patent that it concludes was not infringed may either hear the claim or dismiss it without prejudice" *Liquid Dynamics Corp. v. Vaughan Co.*, 355 F.3d 1361, 1371 (Fed. Cir. 2004) (citing *Nystrom v. TREX Co.*, 339 F.3d 1347, 1351 (Fed. Cir. 2003)).

6. Local counsel for Amgen and Zydus shall contact my chambers to schedule a three-day trial on invalidity to commence in early January 2019;

7. All of the parties have agreed that they are bound by any final judgment of the court as to the invalidity of the asserted claims to be determined by a single trial in this case, currently expected to proceed in January 2019 between Amgen and Zydus;

8. I will take under advisement Zydus' Motion for Judgment Pursuant to Fed. R. Civ. P. 52(c) (D.I. 337) and Motion to Amend the Findings and Judgment of Infringement pursuant to Fed. R. Civ. P. 52(b), 59(e), and 60(b) (D.I. 379); and

9. Pursuant to 28 U.S.C. § 636, this case has already been referred to Chief Magistrate Judge Thyng for purposes of exploring ADR. (*See* D.I. 33). Local counsel for Amgen and Zydus shall contact chambers for Judge Thyng to schedule a mediation between them to occur before the trial on invalidity.

Dated: August 24, 2018



UNITED STATES DISTRICT JUDGE